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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/862,808	05/22/2001	Yijun Deng	ORT-1432	1171
27777	7590	04/05/2004	EXAMINER	
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			ANDERSON, REBECCA L	
			ART UNIT	PAPER NUMBER
			1626	

DATE MAILED: 04/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/862,808

Applicant(s)

DENG ET AL.

Examiner

Rebecca L Anderson

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3, 21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 1-3, 21 and 22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6 January 2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Claims 1-3, 21 and 22 are currently pending in the instant application and are objected. Claims 4-20 and 23-30 were cancelled in the amendment filed 5 June 2003 and claims 1, 21 and 22 were amended in the amendment filed 6 January 2004.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6 January 2004 has been entered.

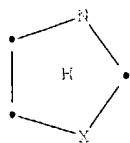
#### ***Information Disclosure Statement***

The information disclosure statement filed 6 January 2004 complies with 37 CFR 1.97(b) since it is filed before the mailing date of a first office action after the filing of a request for continued examination under 1.114. It has been placed in the application file and has been considered.

#### ***Election/Restrictions***

The subject matter of claims 1-3, 21 and 22 other than that wherein:  
**X** is selected from the group consisting of NH and NR<sup>A</sup> wherein R<sup>A</sup> is selected from the group consisting of hydrogen and -R, wherein -R is aralkyl;

Art Unit: 1626



represents a 5 membered aromatic ring structure containing no additional

heteroatoms, optionally substituted with one to three substituents independently selected from the group consisting of halogen, hydroxy, alkyl, halogenated alkyl, alkenyl, cycloalkyl, alkoxy, aryl, aralkyl, amino, mono-or di-substituted amino, cyano, nitro,  $-\text{COOR}$ ,  $-\text{COR}$ ,  $\text{SO}_2\text{R}$  and  $\text{CONR}^{\text{B}}\text{R}^{\text{C}}$ , wherein the amine substituents are independently selected from alkyl, cycloalkyl, aryl or aralkyl, wherein the cycloalkyl or aryl may be further optionally substituted with one or more substituents selected from halogen, hydroxy, alkyl, halogenated alkyl, alkoxy, amino, mono-or di-substituted amino, cyano or nitro;

**Z** is  $\text{OR}^{\text{A}}$  wherein  $\text{R}^{\text{A}}$  is  $-\text{CONR}^{\text{C}}\text{R}^{\text{D}}$ ;

**R<sup>3</sup>** is selected from the group consisting of hydrogen, alkyl, aralkyl, cycloalkyl, and fluorinated alkyl, wherein the aralkyl may be optionally substituted with one or more substituents independently selected from halogen, hydroxy, alkyl, halogenated alkyl, alkoxy, amino, mono-or di-substituted amino, cyano or nitro;

**R<sup>4</sup>** is selected from the group consisting of alkyl, aryl, aralkyl, cycloalkyl, fluorinated alkyl, alkenyl and alkynyl, wherein the alkyl, alkenyl, alkynyl, aryl or aralkyl may be optionally substituted with one or more substituents independently selected from halogen, hydroxy, alkyl, halogenated alkyl, alkoxy, aryl, amino, mono-or di-substituted amino, cyano or nitro;

**R** is selected from the group consisting of alkyl, aryl, aralkyl, cycloalkyl and fluorinated alkyl, wherein the aryl or aralkyl may be optionally substituted with one or more

Art Unit: 1626

substituents independently selected from halogen, hydroxy, alkyl, halogenated alkyl, alkoxy, amino, mono-or di-substituted amino, cyano or nitro;

$R^B$  is independently selected from the group consisting of hydrogen, -R, COOR, -COR,  $SO_2R$ , SOR and  $-CONR^C R^D$ ; and

$R^C$  and  $R^D$  are independently selected from the group consisting of hydrogen, alkyl, aryl, aralkyl, cycloalkyl and fluorinated alkyl, wherein the aryl or aralkyl may be optionally substituted with one or more substituents independently selected from halogen, hydroxy, alkyl, halogenated alkyl, alkoxy, amino, mono-or di-substituted amino, cyano or nitro,

are withdrawn from consideration as being for non-elected subject matter.

The remaining subject matter of claims 1-3, 21 and 22 that is not drawn to the above elected invention stands withdrawn under 37 CFR 1.142(b), as being for non-elected subject matter, for reasons essentially those given in the previous office actions. The remaining compounds which are not within the elected invention, which are independent and distinct from the elected invention and do not have unity with the species elected and therefore are withdrawn by means of a restriction requirement within the claim are, for example, the compounds wherein:

X is  $NRa$  wherein Ra is other than H and -R (wherein -R is only aralkyl), for example, when Ra is  $-CoNR^C R^D$  and wherein -R is alkyl, aryl, cycloalkyl, and fluorinated alkyl,

The 5-membered ring is substituted with one to three substituents selected from heterocyclyl.

The above mentioned withdrawn compounds which are withdrawn from consideration as being for non-elected subject matter differ materially in structure and composition from the compounds of the elected invention. The withdrawn compounds contain varying functional groups which differ from those of the elected invention such as indolyl, imidazolyl, thiazolyl, furyl, etc. which are chemically recognized to differ in structure and function. This recognized chemical diversity of the functional groups can be seen by the various classification of these functional groups in the U.S. classification system, i.e. class 548 subclasses 577(+) (indolyl), class 548 subclasses 300.1(+) (imidazolyl), class 548 subclasses 146(+) (thiazolyl), class 549 subclasses 429 (+) (furyl), etc. Therefore, again, the compounds which are withdrawn from consideration as being for non elected subject matter differ materially in structure and composition and have been restricted properly as a reference which anticipated but the elected subject matter would not even render obvious the non-elected subject matter. Nowhere do applicants argue to the contrary. Nowhere do applicants point out and give reasons why the claims do not involve independent or distinct subject matter.

These withdrawn compounds are independent and distinct from the elected invention and do not have unity with the species elected and are therefore withdrawn by means of a restriction requirement within the claims. The above elected invention does not improperly limit the scope of applicants claims because applicant's claims involve more than one independent or distinct invention. Under 35 U.S.C. 121, the claims may be restricted and the examination limited to a restricted invention. Accordingly,

Art Unit: 1626

restriction as has been presented in this application is proper, repeated and the finality is maintained.

### ***Response to Amendment***

Applicant's amendment filed 6 January 2004 has been entered and claims 1, 21 and 22 were amended. Applicant's arguments filed 6 January 2004 have been fully considered but they are not persuasive. Applicant argues that the pending claims have been amended in accordance with the elected invention identified on pages 3 and 4 of the office action mailed 2 September 2003 indicated to be allowable. However, this argument is not found persuasive since the claims still include non-elected subject matter, such as, for example, wherein the 5 membered aromatic ring structure is optionally substituted with heterocyclyl and optionally substituted heterocyclyl, wherein when X is NRa and Ra is other than hydrogen or -R wherein R is aralkyl.

### ***Objections***

Claims 1-3, 21 and 22 are objected to as containing non-elected subject matter. Claims 1-3, 21 and 22 presented drawn solely to the elected invention as identified supra would appear allowable over the prior art of record.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (571) 272-0696. Mrs. Anderson can normally be reached Monday through Friday 5:30AM to 2:00PM.

Art Unit: 1626

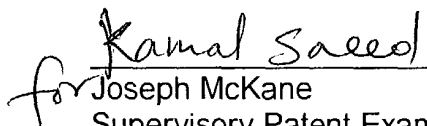
If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph McKane, can be reached at (571) 272-0699.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone numbers are (703) 308-1235 and (703) 308-0196.

A facsimile center has been established. The hours of operation are Monday through Friday, 8:45AM to 4:45PM. The telecopier number for accessing the facsimile machine is (703) 872-9306



Rebecca Anderson  
Patent Examiner  
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for Joseph McKane  
Supervisory Patent Examiner  
Art Unit 1626, Group 1620  
Technology Center 1600